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Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rogue Valley Transportation District

Serial No. 75/510,711

Davis S. D'Ascenzo of Kolisch, Hartwell, Dickenson, McCormack & Heuser for Rogue Valley Transportation District.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Hairston and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 30, 1998, the above-referenced application was filed by Rogue Valley Transportation District, which is a publicly owned entity of Jackson County, Oregon. The application sought registration on the Principal Register of the mark "INTERACTIVE BUS" for "advertising and promotional services and advertising and promotional kits." The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with these services.

The Examining Attorney required applicant to disclaim the descriptive term "BUS" apart from the mark as shown, and required amendment to the recitation of services to clarify the reference to "kits."

Applicant declined to submit the requested disclaimer, but amended the application to recite the services as follows: "advertising services, namely, advertising the goods and services of others in various media on public and private transportation vehicles; and promotional services, namely, promoting the use and awareness of public transportation through the creation and display of various media on public and private transportation vehicles."

The Examining Attorney then refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive of the services identified in the amended application. She held that "applicant's mark merely describes a feature or characteristic of its interactive advertising services, that its advertisements are used in connection with the bus vehicles."

Attached to the refusal to register were copies of excerpts retrieved from the Nexis automated database of published articles. She argued that this evidence "shows that interactive advertising is a form of advertising and buses are commonly used by advertising agencies as a means of advertising goods and services."

This is exactly what this evidence does show, i.e., that "Interactive" is a term used in connection with advertising and that buses are used to advertise

products. Of the dozens of excerpts, however, only four show use of the words "interactive" and "bus" together. The first is from something identified as "Brunico Communications, Inc. Kidscreen" dated November 1, 1998. It is not clear whether this is a printed publication or something available on the Internet, but the article states that "Cartoon Network's 'Dexter's Duplication Machine' is a gigantic traveling bus, dressed up as a laboratory modeled after Cartoon Network's leading show, on the road to promote the prime-time launch of the show as a strip last June. The interactive bus visited 24 cities…" The second relevant excerpt is from the September 3, 1997, edition of The Chicago Tribune. It describes "… a season-long promotion during which an interactive bus with the first-ever 'mobile Website production studio' will be visiting packed parking lots of college football stadiums across the country." The third excerpt is from the April 30, 1997 addition of The Ethnic Newswatch. It states that "Under her watch, the department also implemented the nation's first interactive bus simulator to expose trainees to the rigors of operating a transit vehicle in a real-life environment." The only other excerpt which uses the term sought to be registered is from the November, 1994 edition of The Journal of Systems Management. It states that "Allstate arranged to put kiosks in subway stations (adjacent to the bus arrival area) on the basis of providing the transit authority the opportunity to provide interactive bus schedules to the public."

Applicant responded to the refusal to register with argument that "INTERACTIVE BUS" is not merely descriptive of the services with which

applicant intends to use it. Applicant did not dispute that buses are commonly used by advertising agencies as a means of displaying advertising for the goods and services of others, or that "interactive advertising" is a form of advertising, but contended that neither of these facts supports the conclusion that the combination of "INTERACTIVE" and "BUS" is merely descriptive of the service of advertising the goods and services of others in various media on public and private transportation vehicles or promoting the use and awareness of public transportation through the creation and display of various media on such vehicles.

Applicant pointed out that only four of the many excerpts submitted by the Examining Attorney actually show use of the term applicant seeks to register, and that none of them uses the term descriptively in connection with services in the nature of those recited in the application, which do not involve interaction over the Internet, are not computerized, and are not even electronic. Applicant reiterated that its services involve advertising placed on vehicles.

Further in support of its contention that its mark is not merely descriptive of its services, applicant listed nine registered trademarks which combine the word "INTERACTIVE" with other terms for a variety of goods and services. These marks include "INTERACTIVE TRAINER," "INTERACTIVE DISTRIBUTION," "INTERACTIVE HOMES," and INTERACTIVE DAILY," for, respectively, hydraulic resistance exercise machines, pre-recorded audio tapes and publications featuring advice for entrepreneurs, a newsletter dealing with

interactive electronic communications, and computer software which provides information and graphic displays of residential homes.

The Examining Attorney was not persuaded by applicant's arguments or evidence. In her third Office Action, she maintained the refusal to register under Section 2(e)(1) of the Act, holding that the mark is merely descriptive of the services, but alternatively, that if this is not the case, that the mark is nonetheless unregistrable because it is deceptively misdescriptive of the services with which applicant intends to use it.

Attached to the refusal were copies of a number of third-party registrations which she contended establish that "interactive" is a term used in the advertising industry and that buses are often used to present advertising. She also submitted a dictionary definition of the word "interactive" as "(1). Acting or capable of acting on each other; (2). computer science. Of or relating to a two-way electronic or communications system in which response is direct and continual; (3). Of, relating to, or being a form of television entertainment in which the signal activates electronic apparatus in the viewer's home in order for uses of the apparatus to affect events on the screen, or both."

Additionally, she advised applicant that the list of registrations submitted by applicant in response to the refusal to register did not make said registrations of record, but that copies of the registrations or electronic equivalents of copies could be submitted.

Applicant requested reconsideration of the refusal. Along with this request, applicant submitted print and press materials showing applicant's use of its mark on buses to advertise the goods or services of others or to promote the use an awareness of public transportation. Again, applicant did not dispute that some advertising may be "interactive," or that its own services involve buses, but argued that the combination of these two terms does not immediately and forthwith convey significant information about the services set forth in the application.

With her fourth Office Action, the Examining Attorney repeated and made final the refusal to register under Section 2(e)(1) of Lanham Act, citing both the provision against registration of a mark that is merely descriptive of the goods or services and the provision barring registration of marks which are deceptively misdescriptive of them.

Applicant timely filed a Notice of Appeal, followed by its appeal brief. The Examining Attorney also filed an appeal brief, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

A mark is merely descriptive under Section 2(e)(1) of the Lanham Act if it immediately and forthwith conveys significant information with regard to a quality, characteristic, function, feature, purpose or use of the services with which is, or is intended to be, used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). This determination is not conducted in a vacuum, but rather, whether a mark is merely descriptive must be determined in relation to the

services as they are recited in the application. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The fact that the term may have different meanings in other contexts is not determinative. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Section 2(e)(1) of the Lanham Act also provides that a mark which is deceptively misdescriptive of the services in connection with which it is used or is intended to be used is similarly unregistrable. Whereas a mark is descriptive if it conveys accurate information with regard to the services in question, if the idea conveyed by the mark is false, yet plausible, then the mark is considered to be deceptively misdescriptive of the services. In re Woodward & Lothrop Inc., 4 USPQ2d 1412 (TTAB 1987).

Based on careful consideration of the record in this application in light of the arguments made by both applicant and the Examining Attorney, as well as the relevant legal authority on these issues, we hold that neither cited provision of Section 2(e)(1) of the Lanham Act supports refusing registration in this case. Simply put, this record does not show that the combined term "INTERACTIVE BUS" immediately and forthwith conveys, either accurately or inaccurately, any significant information about the services recited in this application.

As noted above, it is clear that advertising can be interactive, i.e., it can utilize a two-way electronic or communication system featuring direct response. Likewise, is apparent from this record that applicant's advertising services involve buses. Applicant is a public transportation company, and the materials

submitted with the request for reconsideration show pictures of buses on which advertisements are presented.

While applicant's advertisements may be considered "bus" advertising, such advertising is not, however, "interactive," within common usage of this term as evidenced by the dictionary definition made of record by the Examining Attorney. Moreover, nothing in this record establishes that there is anything known as "interactive bus" advertising, or that the word "interactive" is ever used in connection with advertising on buses. The evidence of record also supports the conclusion that the mark "INTERACTIVE BUS" is somewhat incongruous for applicant's services. It is not clear what "interactive bus" advertising and promotional services would be. The four excerpts retrieved from the Nexis database which do show use of the combined term sought to be registered, "INTERACTIVE BUS," certainly do not show use of this combination in a descriptive sense in connection with the kind of advertising and promotional activities recited in this application.

In summary, because this mark, in it entirety, does not immediately convey significant information with regard to the services set forth in the application, and because it likewise does not convey false information with regard to those services, Section 2(e)(1) of the Lanham Act does not prohibit its registration.

As noted above, however, the record does establish that the word "BUS" is merely descriptive of these services. The word describes a feature or

characteristic of the services because buses are used to display applicant's advertisements and promotions. Accordingly, the requirement for a disclaimer of the word "BUS" apart from the mark as shown is plainly appropriate. We consider the disclaimer requirement made in the first Office Action to have been merged with the subsequent refusal to register the entire mark under Section 2(e)(1), so if applicant submits such a disclaimer within thirty days of the issuance of this ruling, the refusal to register will be reversed. In the absence of the disclaimer, the refusal to register will be affirmed.